REMARKS

The Examiner has rejected claims 1, 3-5, 21, 22, 24-26, 39 and 40 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The written description must convey with a reasonable clarity to those skilled in the art that as of the filing date should, he or she was in possession of the invention.

Applicants submits that the term/phrase a centrally acting acetyl cholinesterase inhibitor is understood by one of ordinary skill in the art. Attached is Chapter 8 titled "Anticholinesterase Inhibitors" from Goodman & Gilman's The Pharmacological Basis of Therapeutics, Ninth Edition (eds. Joel G. Hardman and Lee E. Limbird, McGraw-Hill, 1996), which is a standard reference book in the pharmaceutical field.. The Examiner's attention is drawn to the first paragraph of this chapter which reads "Drugs that inhibit AChE are called anticholinesterase (anti-AChE) agents. They cause Ach to accumulate at cholinergic receptor sites and thus are potentially capable of producing effects equivalent to excessive stimulation of cholinergic receptors throughout the central and peripheral nervous systems. "

Therefore, since one of ordinary skill in the art would understand the meaning of the term acetyl cholinesterase inhibitor, the written description requirement has been met.

Therefore, it is respectfully requested that this rejection be withdrawn.

The Examiner has rejected claims 21, 24-26 and 28-40 under 35 USC 112, first paragraph as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The Examiner states that the specification does not describe what is meant by the term/phrase a disease or condition in which it is desirable to administer a centrally-acting acetyl cholinesterase inhibitor.

The Examiner's attention is drawn to page 2, the first 4 lines under "Detailed Description of the Invention" where it is stated that acetylcholinesterase inhibitors of use in the present invention are those that have a central effect and have a medium duration of action for treatment of diseases where acetylcholinesterase inhibiting activity in the brain is desired.

The Examiner's attention is also again directed to Chapter 8 from Goodman & Gilman's The Pharmacological Basis of Therapeutics discussed above which describes diseases and conditions in which it is desirable to administer a centrally-acting acetyl cholinesterase inhibitor. Therefore, since the conditions for which it is desirable to administer centrally-acting acetyl cholinesterase inhibitor are known, there is no requirement that the conditions be listed in the specification in order to meet the written description requirement.

Accordingly, it is respectfully requested that this rejection be withdrawn.

The Examiner has rejected claims 1, 3-5, 7-21, 22, 24-26, and 28-38 under 35 USC 103(a) in view of Shapiro and Conte.

Applicant respectfully traverses this rejection.

According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

> (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the standard with which obviousness is determined.

In making the obviousness rejections in this application, the Examiner is relying on impermissible hindsight.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See Panduit Corp. V. Dennison Manufacturing Co. 227 USPQ 337, 343 (Fed. Cir. 1985):

> It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.

In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. Vandenberg v. Dairy Equipment, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing In re Sponnoble, 160 U.S.P.Q. 237 (CCPA 1969). In Uniroyal . Rudkin-Wiley, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

> The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

There is no combination of these references which suggests a formulation of a centrally acting acetyl cholinesterase inhibitor having a half life of from one to eleven hours wherein the acetyl cholinesterase inhibitor is formulated so as to delay its activity for a predetermined period of from four to twelve hours.

Conte states that "there is an increasing awareness that the drug must be administered not only in the right amount at a proper rate but also at the right time." Conte then refers to drugs such as antiasthmatic, anti-histaminic, psychotropic, anaesthetic, cardiovascular active drugs, NSAIDs, etc. that have significant daily variations in pharmackokinetics and/or drug effects have been demonstrated in man, depending on physiological and/or physiopathological changes of circadian rhythmicity. Conte then gives the example of asthma and hypertension and states that an asthmatic attack generally happens in the early morning and that in hypertension diseases the pressure value is higher during the daytime. The teaching of Conte is directed to drugs that should be administered at a specific time of day in order to have the most beneficial effect. This differs from the invention claimed in this application wherein the time of delivery of a formulation of acetyl cholinesterase inhibitors is not of any particular significance. As stated as an example in the previous response, Alzheimer's does not have diurnal variation and treatment is not controlled by circadan rhythm.

There is no motivation to combine Conte with either Brossi or Shapiro and the attempt to do so is based on hindsight. Furthermore, as stated above there is no disclosure or suggestion in the combination of these references of a dosage form wherein the acetylcholinesterase has a half life of from one to eleven hours and is formulated so as to delay its activity for a predetermined period of from four to twelve hours.

Therefore, it is respectfully requested that the rejections be withdrawn.

The rejections under 35 USC 112, second paragraph are moot in view of the amendment of claims 3, 4, 24 and 25.

Applicant submits that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted

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